

Appl. No. 10/691,982
Amdt. Dated 7/18/2005
Response to Office action dated 5/25/2005

REMARKS

Claims 1-58 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims and have been amended, and claims have been canceled, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1, 2, 5, 13, 14, 16, 21, 27, 28, 30, 35, 39, 40, 43, 49, 50 and 53 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Objections

The Examiner objected to claims 1-58 due to certain informalities. The Examiner stated, "The limitations in the claims must be separated by semicolons and furthermore, the word 'and' should be inserted between the last limitation and the limitation that proceeds it. Appropriate correction is required." This objection is respectfully traversed.

While it may be common for claims to have the punctuation and conjunction required by the Examiner, this is not necessary and the contemporary view is that they should be omitted. Notably, the Examiner cited to no authority in support of this objection, and there is no such authority.

Appl. No. 10/691,982

Amdt. Dated 7/18/2005

Response to Office action dated 5/25/2005

In the interest of expediting allowance, the claims have been amended as required by the Examiner. Out of caution, commas and colons have been added to some additional claims to avoid further objections. However, no meaning should be ascribed to the making of these amendments or to the presence of the new punctuation or conjunctions.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-11, 13-22, 24-36, 38-47 and 49-57 under 35 USC § 102(e) as anticipated by Nelson et al. (US Publication 2004/0246946 A1). This rejection is respectfully traversed.

Nelson is directed to an IP telephony system in which an IP phone has a web server embedded in firmware. This configuration allows a user with a PC to browse to the IP phone. Nelson discloses a number of services supported by the IP phone:

[0037] As discussed above, since IP telephony devices 22 are directly coupled to an IP network, such as LAN 20, these devices are capable of acting as Web servers. Embedding a Web server in an IP phone provides many advantages. The Web server allows a direct functional interface with the telephone, allowing end users to control and operate most of the functions of the telephone from a Web browser. The browser interface to the telephone also allows end users to perform many administrative functions on the telephone, including, but not limited to assignment of speed numbers, key definitions, and IP addresses. Furthermore, a complete HyperText based user/help guide may be made available on the phone's Web server, or the phone may provide links to help files located on other devices. It will be understood that although a Web server is described as being embedded in an IP phone, this concept can also be applied to any other type of network device connected to a communications network, such as communications network 10.

Nelson describes the operation of the IP phone as a phone, and separately describes the functions available from a web browser on a PC connecting to the IP phone. In FIG. 2, Nelson

Appl. No. 10/691,982
Amdt. Dated 7/18/2005
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shows a block diagram of the IP phone. In contrast, the flow charts and screen shots of Nelson's FIGS. 3-9 show operation of the PC.

Claim 1 is quite different from Nelson. Claim 1 is directed to a method of application independent telephone call initiation. This method includes the step of "providing a computer having ... an application program and a telephone call module." The application program comprises "an integrated body of computer software comprised of one or more files, modules or parts that calls operating system services and performs work for a user." The telephone call module comprises "software distinct from the application program and operating apart from the application program."

In rejecting claim 1, the Examiner relies on Nelson's PC as disclosing the claimed computer. Yet, the Examiner relies upon Nelson's IP phone as disclosing everything else. The Examiner cited to Nelson's functional interface 100 in FIG. 3 as disclosing a display, an application program and a telephone call module. But Nelson's FIG. 3 discloses only a screen display of a web browser. Nelson clearly discloses that all telephone call operations are performed by the IP phone (FIG. 2). Nelson's PC and IP phone are distinct devices.

Nelson nowhere discloses, teaches or suggests a computer having the claimed telephone call module. Nelson discloses only a PC with a web browser, and an IP phone for making phone calls. Nelson's PC cannot make phone calls – at best it can cause the IP phone to make phone calls. Once initiated, all calls from Nelson's IP phone are handled exclusively by the IP phone. Notably, in the speaking and hearing of the phone calls are done only on the phone – not at all on the PC. This highlights that the devices are distinct.

That Nelson fails to disclose, teach or suggest the invention of claim 1 becomes even more apparent with consideration of other limitations in claim 1. Claim 1 recites, "the telephone call module recognizing the activation of the displayed telephone number." The Examiner states that this step is disclosed by "step 204 of figure 3 where the HTTP request message is sent to the destination phone by the web browser." In other words, the Examiner relies upon the web browser as both the

Appl. No. 10/691,982

Amdt. Dated 7/18/2005

Response to Office action dated 5/25/2005

application and the telephone call module. This is expressly negated in claim 1, which recites that the telephone call module is “software distinct from the application program and operating apart from the application program.” Clearly, Nelson does not anticipate these aspects of claim 1.

Claim 1 further recites, “the telephone call module, in response to recognizing the activation of the displayed telephone number, causing a signal to be sent to a switch instructing the switch to initiate a telephone call between a predefined telephone number and the displayed telephone number.” The Examiner cited to Nelson’s FIG. 2 – the IP phone – as disclosing this limitation. That citation is improper. The IP phone is not part of Nelson’s PC, and the Examiner had already relied upon the PC’s browser as disclosing the telephone call module.

Furthermore, the Examiner has pointed to nothing in Nelson which discloses a telephone call module “recognizing the activation of the displayed telephone number”. At best, Nelson’s web browser recognizes activation of a displayed phone number, but this would conflict with the claim’s requirement that the telephone call module sent a signal to a switch. Nelson’s web browser has no such ability, and cannot be both the application and the telephone call module.

There is yet another difference between Nelson and claim 1. Claim 1 recites “causing a signal to be sent to a switch instructing the switch to initiate a telephone call between a predefined telephone number and the displayed telephone number.” Nelson has nothing like this. Nelson discloses only one telephone number – the one that a user enters or selects from a speed dial list. Nelson has no disclosure, teaching or suggestion of signaling a switch to initiate a telephone call between two telephone numbers. Nor does Nelson disclose, teach or suggest the claimed “predefined telephone number”. The Examiner cites to Nelson’s call manager as a switch. However, the term “switch” has an accepted meaning in the telephony arts, and Nelson’s call manager clearly is not a switch.

As can be seen, Nelson falls far short of disclosing the invention of claim 1. It is like trying to push a square object through a round hole. Nelson does not fit.

Appl. No. 10/691,982

Amdt. Dated 7/18/2005

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The other independent claims have similar though not identical limitations, so one or more of the arguments with respect to claim 1 apply to the other independent claims: the Examiner's attempt to push Nelson through claims 13, 27, 39 and 49 fails in the same ways. Since Nelson does not disclose, teach or suggest the method of claim 1, Nelson also fails to disclose, teach or suggest the computer program product of claim 13, the client computer of claim 27, the method of server-based telephone call initiation of claim 39, and the computer program product of claim 49.

Strangely enough, though claims 39 and 49 are directed to a server or its operations, the Examiner rejected these claims with almost the identical citations to Nelson as claim 1. The Examiner is respectfully requested to consider each claim and present arguments directed to the particular limitations of each claim.

Nelson entirely fails to disclose the limitations of the dependent claims. The rejections of the dependent claims amounts to hand waving and does not merit a response. The undersigned recognizes that the Examiner is surely very busy and overworked. However, the applicant paid all government fees due and deserves a full, thorough and fair examination. Considerable time, effort and money have been invested in this application. The record reflects that the undersigned undertook a careful prior art search, and the claims were drafted with a reasonable expectation of allowance. If the Examiner cannot find good art, he is respectfully requested to do the right thing and allow the claims.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 12, 23, 37, 48 and 58 under 35 USC § 103 as obvious from Nelson in view of Greenberg et al. (US Publication 2001/0038624 A1). This rejection is respectfully traversed.

Because Nelson fails to disclose, teach or suggest the independent claims, the Examiner's rejection of claims 12, 23, 37, 48 and 58 also fails. It is noted, however, that the same failed mode of analysis of the independent claims applies to the Examiner's rejection of claims 12, 23, 37, 48 and

Appl. No. 10/691,982
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58. For example, the Examiner's argument for motivation to combine does not in any way explain why there is motivation to combine Greenberg with Nelson, or that such a combination would even work. In fact, given Nelson's shortcomings it is not even clear how Greenberg would be combined with Nelson.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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